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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER KANERVO, VIRPI H				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 06/30/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/804,851

Applicant(s)

SANKARAN ET AL.

Examiner

VIRPI H. KANERVO

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/13/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-35 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 21-35 and 38-42 are presented for examination. Applicant filed an amendment on 04/13/2009 amending claims 35 and 39; and adding new claim 42. Examiner has carefully considered Applicant's arguments and amendments directed to the § 112 rejection, but finds them not sufficient to overcome the rejection. Therefore, Examiner maintains the previous § 112 rejection in the instant Office action. Examiner has also carefully considered Applicant's arguments and amendments directed to the § 101 rejection, but finds them not sufficient to overcome the rejection. Therefore, Examiner maintains the previous § 101 rejection in the instant Office action. Examiner has also carefully considered Applicant's arguments directed to the § 103 rejection, but finds them not sufficient to overcome the rejection. Since Examiner has maintained the previous grounds of § 103 rejection of claims 21-35 and 38-41, and the newly added claim 42 is rejected as unpatentable under the same prior art as the other claims, the rejection of claims 21-35 and 38-42 is a FINAL rejection of the claims.

Response to Arguments

2. Applicant's arguments with respect to the § 112 rejection of claim 31 have been considered, but they are not sufficient to overcome the rejection. While Applicant argues that the amended claim 31 should overcome the § 112 rejection, Examiner cannot find any amended features in claim 31. Furthermore, the status identifier of claim 31 is "Previously Presented." Therefore, Examiner maintains the § 112 rejection of claim 31 in the instant Office action.

3. Applicant's arguments and amendments with respect to the § 112 rejection of claim 39 have been considered, but they are not sufficient to overcome the rejection. Applicant argues that the amended claim 39 should overcome the § 112 rejection. However, the amended feature "wherein each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization" does not cure the previous § 112 rejection because it does not clarify whether the "means for" elements of the claim refer to the software or the hardware described in the specification. Therefore, Examiner maintains the § 112 rejection of claim 39 in the instant Office action.

4. Applicant's arguments and amendments with respect to the § 101 rejection of claim 35 have been considered, but they are not sufficient to overcome the rejection. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC § 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.* Further, the amended feature "wherein each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization" does not cure the previous § 101 rejection because it is not clear whether it refers to the software or the hardware. Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claim 35 is non-statutory. In the instant case, Applicant could cure the § 101 rejection, *e.g.*, by carrying out the critical steps of the method by a computer.

5. Applicant's arguments and amendments with respect to the § 101 rejection of claim 39 have been considered, but they are not sufficient to overcome the rejection. The amended feature "wherein each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization," as well as the previous "means

for,” could be interpreted as either hardware or software. Since the claimed invention could be interpreted as consisting entirely of software, the claim is not considered statutory because software is non-patentable subject matter. In the instant case, Applicant could cure the § 101 rejection, *e.g.*, by having processor as an element of the claimed apparatus.

6. Applicant's arguments with respect to the § 103 rejection of claims 21, 31, 35, 38, 39, and 40, have been considered, but they are not sufficient to overcome the rejection. Applicant argues that Their (7,130,822 B1) fails to disclose a private area because “while a contributor may have limited view into the hierarchy, a high level executive (*e.g.*, Guy) can view *the entire hierarchy*” and therefore “the contributor’s portion of the hierarchy is not a private area.” Examiner disagrees. Their specifically discloses that “each contributor has a limited view such that left frame only displays the part of the hierarchical model that relates to the particular contributor” (Their: col. 6, lines 43-45). While Their further discloses that “high-level executive defined as a reviewer for all five regions can view the entire hierarchy” (Their: col. 6, lines 45-47), each contributor still cannot view the entire area, but only the area that relates to the particular contributor. The system of Their allows a user to keep the data private until the budget is final, at which point the data may be submitted and processed. Thus, Their discloses “a private area.”

7. Applicant's arguments with respect to the newly added claim 42 have been considered, but they are not sufficient to overcome the rejection. Applicant argues that Their does not disclose "receiving a selection of one of the plurality of expense plans to provide a selected expense plan." Examiner disagrees. Their discloses specifically that "the budgeting system captures forecast data from contributors associated with nodes of a lower level of hierarchy, propagates the forecast data up the hierarchy based on reviews received at by contributors at each level" (Their: col. 1, lines 36-40). Therefore, Their discloses "receiving a selection of one of the plurality of expense plans to provide a selected expense plan."

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claim 31 and 39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 31, the following phrases lack antecedent basis, and it is unclear as to how they interrelate with the claimed invention:

“each node” (line 6)

“data hierarchy” (line 9)

“organizational data hierarchy” (lines 10-11).

As to claim 39, It is unclear whether the means for refer to the software or the hardware described in the specification. See the rejection under 35 U.S.C. § 101, below.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 35 and 39 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 35, the claim language recites a process comprising the steps of receiving data, creating data, and storing data. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform

underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parkerv. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

As to claim 39, the specification describes the claimed steps as being modules on a web-based application server. The "means for" could be interpreted as either the server and network, or the software modules. Since the claimed invention could be interpreted as consisting entirely of software, the claim is not considered statutory, because software is not a patentable subject matter.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in § 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
14. Claims 21-35 and 38-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lautzenheiser (6,351,734 B1) in view of Their (7,130,822 B1).

As to claims 21, 24-35, 38-41, Lautzenheiser teaches a system and method for associating information with elements of an organization, comprising creating and storing a stored organization data hierarchy that represents the organization and the sub-organizations and comprises a plurality of hierarchical levels (Lautzenheiser: col. 6, lines 1-42); receiving first data input that specifies a spending capacity for at least a portion of the organization (Lautzenheiser: col. 4, lines 52-58; and col. 9, lines 17-21); in response to receiving the first data input, creating and storing spending capacity data in a public area, wherein the spending capacity data defines the spending capacity based on the first data input (Lautzenheiser: col. 4, lines 63-67); receiving second data input that specifies one or more planned expense allocations of the portion of the organization (Lautzenheiser: col. 4 lines 59-62; and col. 9, lines 15- 17); in

response to receiving the second data input, creating and storing planned expense data, where the planned expense data defines the one or more planned expense allocations based on the second data input (Lautzenheiser: col. 5, lines 21-24); automatically determining whether the planned expense data exceeds the spending capacity data, and transmitting a notification that the planned expense data exceeds the spending capacity data when the planned expense data exceeds the spending capacity data and (Lautzenheiser: col. 5, lines 24-29; and col. 9, line 59 – col. 10 line 5); entering new data in the same manner as described above with a new first data input and a new second data input (Lautzenheiser: col. 5, lines 18-20; and col. 10, lines 6-15).

Lautzenheiser fails to teach initially storing the planned expense data in a private area, and storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data; that the private area is configured to store a plurality of expense plans for the portion of the organization; receiving a selection of one of the plurality of expense plans to provide a selected expense plan; and that each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization. Their teaches a system and method for budget planning. The system of Their is similar to the system of Lautzenheiser in that it relies on individual contributions to form the resource allocation in a hierarchical manner. Their teaches storing planned expense data

in a private area (Their: col. 6, lines 41-47), and storing the planned expense data in the public area when the planned expense is approved (Their: col. 5, line 62 – col. 6, line 5); that the private area is configured to store a plurality of expense plans for the portion of the organization (Their: col. 1, lines 27-33; and Fig. 4); receiving a selection of one of the plurality of expense plans to provide a selected expense plan (Their: col. 1, lines 36-43; and Fig. 5, label 43); and that each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization (Their: col. 1, lines 27-33; and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Lautzenheiser by initially storing the planned expense data in a private area, and storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data; that the private area is configured to store a plurality of expense plans for the portion of the organization; receiving a selection of one of the plurality of expense plans to provide a selected expense plan; and that each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization of Their because it is desirable that a user be able to use the system of Lautzenheiser without finalizing the results. Using the invention of Lautzenheiser, a user may desire to fill in numbers

and see if the numbers are flagged for being "over-budget." Their teaches a method for submitting the budget to a higher node of the hierarchy, which includes a private area where the information is only viewable by the user working on it, and a public area, where the information is made public when it is approved by a higher node. The system of Their allows a user to keep the data private until the budget is final, at which point the data may be submitted and processed, as is described by Lautzenheiser.

As to claims 22, 23, the claim limitations are considered non-functional descriptive language, as it recites the intended use of the claimed method. The recitation of who the data is for, what the data represents, and how the data is used does not further limit or narrow the claimed method. The method is performed in the same way regardless of what the data represents, and therefore the language is not given weight in determining patentability over the prior art.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tobin (2002/0077992 A1) discloses personal transaction device with secure storage on a removable memory device.

Vanzini (7,255,282B2) discloses PCMCIA-complaint smart card secured memory assembly for porting user profiles and documents.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIRPI H. KANERVO whose telephone number is 571-272-9818. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Virpi H. Kanervo

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691